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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/074,683 05/08/98 VAN RYZIN

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EXAMINER

JERRY A MILLER  
SONY CORPORATION OF AMERICA  
1 SONY DRIVE MD T1 1  
PARK RIDGE NJ 07656

HOMER, I

ART UNIT

PAPER NUMBER

2177

DATE MAILED:

08/02/01

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

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# Office Action Summary

Application No.  
09/074,683

Applicant(s)  
Van Ryzin

Examiner  
Jean R. Homere

Art Unit  
2177



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 25, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-25 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Response to Amendment*

1. Applicant's arguments filed on 05/16/2001 have been fully considered but they are not persuasive.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-14, 16-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/074,681. Although the conflicting claims are not identical, they are not patentably distinct from each other. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application

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since the referenced copending application and the instant application are claiming common subject matter. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. Claims 1-14, 16-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/074,681. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art of data processing to modify the invention as instantly claimed since such modification would not have interfered with the functionality of the method as claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14, 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douma et al. ('Douma' hereinafter), U.S. Patent No.5,990,884, in view of Montoya et al ('Montoya', hereinafter), U.S. Patent No.5,949,688.

As to claims 1-2, Douma substantially discloses the invention including a PC having a CPU, a storage medium and audio visual accessing capability (col.4, lines 1-8, et seq). In particular, Douma discloses the creation of a custom playlist on an external device (col.2, lines 47-49 et seq). Further, Douma discloses the transfer of the custom playlist to a digital audio/visual device (col.2, lines 54-61 et seq). Additionally, Douma discloses a data storage medium physically connected on the PC for storing selected audio titles, wherein said storage medium can be searched according to plurality of attributes (col.4, lines 1-27, et seq). Douma also discloses a GUI for allowing users to interface with the recording medium (col.5, lines 12-15, et seq).

Douma does not particularly detail the saving of the customized playlist on a virtual CD, which is capable of being modified upon demand. However, Montoya discloses an analogous system for allowing customers to compile a series of desired tracks on a CD recording unit, whereby a customer scans the available titles and selects the desired tracks therefrom to thereby generate a desired playlist on the CD (col.3, lines 2-13 et seq), and whereby the selections on the

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CD can be modified/updated upon user's request (col.4, lines 33-36 et seq). It would have been obvious to one of ordinary skill in the art of data processing to combine the teachings of the cited references. Montoya's teachings would have allowed users of Douma's system to be able to customize a CD according to their volition.

As to claim 3, Douma discloses the collection of tracks to be obtained by the actuation device from an external source (col.3, lines 52-56, et seq).

As to claims 4, 8, Douma discloses the reading of table of contents of each source medium to obtain information about the plurality of tracks (col.4, lines 30-41, et seq).

As to claim 5, Douma discloses a two way communication link with the external device (fig.1, items 24, 28, et seq).

As to claim 6, Douma discloses the Internet as the external information source (fig.1, item 22, et seq).

As to claim 7, Douma discloses searching a plurality of tracks for titles and track names stored in the DB of a PC (col.4, lines 1-4, et seq).

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As to claim 10, Douma discloses the downloading of the selected file to the actuation device over a communication link, whereby said downloaded file is stored locally on the actuation device (col.6, lines 21-26 et seq).

As to claims 11-13, Douma discloses cable, infra red and wireless as possible communication links (col.6, lines 41-50 et seq).

As to claim 23, Douma discloses the retrieval and selection of information about a plurality of tracks that are available to be added to a custom list (col.4, lines 14-28, et seq). Further, Douma discloses table of contents (TOC) for identifying each disk or tape and the tracks available thereon (col.4, lines 37-41, et seq).

7. The limitations of claims 9, 14, 16- 22, 24-25 have already been addressed in the rejection of claims 1-8, 10-13 and 23 above. They are therefore rejected on similar grounds.

***Remarks***

Applicant argues that the prior art of record and the copending application do not detail the storage of a custom playlist in a nonvolatile memory. In response to the preceding arguments, the examiner notes that the cited limitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight

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where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Even if the nonvolatile limitation were recited in the body of the claim, it would not distinguish the claimed invention from the cited references since Douma's disclosed PC contains a RAM and ROM, as do all PCS, and these types of memories are inherently nonvolatile.

Further, applicant argues that the prior art of record does not detail a virtual CD, which is achieved by storing the transferred custom playlist on the storage medium of the PC, whereby said custom playlist is modifiable, and whereas Montoya's custom playlist on a physical CD is not modifiable. In response to the preceding argument, the examiner submits that the invention as claimed does not recite the "virtual CD" limitation. Therefore, these arguments are moot since they have no basis in the claims. Even if this limitation were recited in the claim, it would not distinguish the invention from the prior art of record since the combined references amount to such teaching. Douma discloses a PC having a nonvolatile memory, which is capable of storing a playlist, and wherein said playlist is modifiable. Although Douma does not particularly detail the selection of a playlist to be stored on the nonvolatile memory, Montoya's disclosure of the custom playlist would complement Douma's by allowing users of the Douma-Montoya's system to store the custom playlist on Douma's nonvolatile memory to yield the instant invention. Such a combination would have been obvious to the ordinary skilled artisan at the time of the invention



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since the artisan would seek to benefit from the flexibility of the memory of a PC as opposed to a CD given readily availability of both media.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean R. Homere whose telephone number is (703)-308-6647. The examiner can normally be reached on Monday-Friday from 08:30 a.m.-5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on Monday-Friday from 8:00 a.m. to 3:30 p.m. at (703)-305-9790.

**Any response to this action should be mailed to:** Commissioner of Patents and Trademarks Washington, D.C. 20231, **or faxed to:** (703) 308-9051, (for formal communications intended for entry), **Or:** (703) 305-9731 (for informal or draft communications, please label "PROPOSED" or "DRAFT"). Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). The facsimile phone number for this group is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Jean R. Homere  
Jean R. Homere  
Primary Examiner, A.U. 2177  
July 31, 2001

  
JEAN R. HOMERE  
PRIMARY EXAMINER